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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,876	02/03/2004	Richard H. Blunk	GP-301597	1052

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CARY W. BROOKS
General Motors Corporation
Legal Staff, Mail Code 482-C23-B21
P.O. Box 300
Detroit, MI 48265-3000

EXAMINER

LEWIS, BEN

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/770,876

Applicant(s)

BLUNK ET AL.

Examiner

Ben Lewis

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-25 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-25 and 31-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

1. The Applicant's amendment filed on August 30th, 2007 was received. Claims 22 was amended. Claims 1-21 and 26-30 were cancelled.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action (issued on May 30th, 2007).

Claim Rejections - 35 USC § 102

3. Claims 22-25, 31-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Fronk et al. (US 6,372,376 B1).

With respect to claims 22,24, Fronk et al. teach a method of making a current collector for a fuel cell comprising coating a metal substrate with a layer of protective coating. The coating comprises a mixture of electrically conductive particles dispersed throughout an oxidant- resistant and acid-resistant, water-insoluble polymeric matrix. The mixture comprises graphite particles (filler) and other electrically conductive particles selected from the group consisting of gold and carbon (particle). The mix is applied to the substrata followed by drying and curing of the coating. See Column 6, Lines 1-51, Claim 1.

With respect to claims 23,34 Fronk et al. teach the coating can be applied by spraying the particles onto the substrate. See Column 5, Lines 21-23. Fronk et al. do not specifically disclose the spraying pressure of the coating. However, it is the position of the examiner that such properties of said process are inherent, given that the Fronk and the present application utilizing the same spraying method to apply the coating. A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. Inherency is not established by probabilities or possibilities. In re Robertson, 49 USPQ2d 1949 (1999). Applicant is advised to submit other information with respect to the Fronk's spraying process, if it is shown to be patentably distinct from the instant invention.

With respect to claim 25, Fronk et al. teach the substrate is aluminum or stainless steel. See Column 5, Lines 10-20.

With respect to claims 31,32, Fronk et al. teach the particles is selected from the group consisting of gold, platinum, palladium, rhodium, rare earth metals or carbon. See Claim 1.

With respect to claim 33, Fronk et al. do not specifically disclose the concentration of the particles present in the composite coating. However, it is the position of the examiner that such characteristic is inherent, given that the Fronk and the present application utilizing the same spraying method to apply the coating. A reference which is silent about a claimed invention's features is inherently anticipatory if

the missing feature is necessarily present in that which is described in the reference.

Inherency is not established by probabilities or possibilities. In re Robertson, 49 USPQ2d 1949 (1999).

With respect to claim 35, Fronk et al. further teach the method comprising placing a diffusion media (34,36,38,40) adjacent to the current collector. See Figure 1.

With respect to claim 36, Fronk et al. further teach the method comprising placing a MEA (4,6) adjacent to the diffusion media. See Figure 1.

Response to Arguments

4. Applicant's arguments filed on August 30th, 2007 have been fully considered but they are not persuasive.

Applicant's principal arguments are

(a) For example, the rejection ignores the recitation "coating an electrically conductive substrate with a tacky layer of uncured or undried material comprising a corrosion-proof, electrically-conductive filler dispersed throughout an oxidation-resistant and acid-resistant polymer" and "embedding a plurality of electrically-conductive particles in a surface of said layer" and "so as to increase the conductivity of said surface over the conductivity of the remainder of said material" and "curing or drying said layer." Fronk et

al simply does not identically disclose or suggest such a method. No prima facie case of anticipation has been established.

(b) The Examiner also takes the position that Fronk et al does not disclose the spraying pressure "of the coating" but maintains such is inherent. Again, Applicants' claim 23 calls for spraying particles, not the coating. Furthermore, the Examiner's position with respect to inherency is completely misplaced. Because the Examiner cannot find a claim limitation in the prior art, the Examiner cannot simply state that such is inherent. In order for the principal of inherency to be appropriately applied, following the reference must necessarily produce the claimed invention. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd.Pat.App.&Inter.1990). MPEP 2112. The Examiner has provided no rationale or explanation why following the reference would necessarily produce the specific act recited in claim 23 of "spraying the particles on said surface" of the tacky layer of uncured or undried material. Claim 34 includes similar language as claim 22, and is patentable on the same basis. No prima facie case of anticipation has been established with respect to claims 23,34.

(c) With respect to claim 33, the Examiner has taken the position that Fronk et al does not disclose the concentration of the particles present in the composite coating however, that such characteristics would have been inherent given that Fronk et al and the present application utilizes the same spraying method to apply the coating. Again,

when the Examiner cannot find called for limitations in the claims, the Examiner cannot simply state that such missing limitations are inherent without providing some evidence that following the reference would necessarily produce the claimed invention. That is, following the reference must produce the claimed invention. Again, Fronk et al does not identically disclose or suggest embedding particles in a surface of a tacky layer of uncured and undried material which already includes a conductive filler. Claim 33 requires that the embedding of the particles are such that the particles are present in a higher concentration in the surface than the remainder of the composite. Fronk et al simply does not identically disclose or suggest the same. No prima facie case of anticipation of claim 33 has been established.

In response to Applicant's arguments, please consider the following comments.

(a) Fronk et al. teach a method of making a current collector for a fuel cell comprising coating a metal substrate with a layer of protective coating. The coating comprises a mixture of electrically conductive particles dispersed throughout an oxidant-resistant and acid-resistant, water-insoluble polymeric matrix. The mixture comprises graphite particles (filler) and other electrically conductive particles selected from the group consisting of gold and carbon (particle). The mix is applied to the substrata followed by drying and curing of the coating. See Column 6, Lines 1-51, Claim 1. (

Examiner notes that since the coating mix of Fronk et al. is subjected to drying and curing then the coating mix of Fronk et al. is uncured and undried when applied as a coating. Also, since the material is applied as coating that must be dried then the mixture is inherently tacky.

(b) Fronk et al. teach the coating can be applied by spraying the particles onto the substrate. See Column 5, Lines 21-23. Fronk et al. do not specifically disclose the spraying pressure of the coating. However, it is the position of the examiner that such properties of said process are inherent, given that the Fronk and the present application utilizing the same spraying method to apply the coating. A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. Inherency is not established by probabilities or possibilities. In re Robertson, 49 USPQ2d 1949 (1999). Applicant is advised to submit other information with respect to the Fronk's spraying process, if it is shown to be patentably distinct from the instant invention.

Furthermore, unless Applicant shows objective evidence with regard to Fronk et al's spray coating method being different and incapable of performing the same coating function as claimed by Applicant then Applicants comments alone are not persuasive. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

(c) Fronk et al. do not specifically disclose the concentration of the particles present in the composite coating. However, it is the position of the examiner that such characteristic is inherent, given that the Fronk and the present application utilizing the same spraying method to apply the coating. A reference which is silent about a claimed invention's features is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. Inherency is not established by probabilities or possibilities. In re Robertson, 49 USPQ2d 1949 (1999).

Furthermore, unless Applicant shows objective evidence with regard to Fronk et al's spray coating method being different and incapable of performing the same coating function as claimed by Applicant then Applicants comments alone are not persuasive. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ben Lewis whose telephone number is 571-272-6481. The examiner can normally be reached on 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Ben Lewis



PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER

Patent Examiner
Art Unit 1795